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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,092	03/19/2004	Howard E. Farran	12519-002	7714
48276 7590 09/30/2009 TIFFANY & BOSCO CAMELBACK ESPLANADE II, THIRD FLOOR 2525 EAST CAMELBACK ROAD PHOENIX, AZ 85016				
EXAMINER CARLSON, JEFFREY D				
ART UNIT 3622		PAPER NUMBER		
NOTIFICATION DATE 09/30/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lm@tblaw.com

### Office Action Summary

**Application No.**

10/805,092

**Applicant(s)**

FARRAN, HOWARD E.

**Examiner**

Jeffrey D. Carlson

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16-40 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-40 and 42-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Requirements For Information – Rule 105***

1. Applicant has chosen to attempt to swear behind the Jan/Feb 2003 issue of Dental Practice Report (DPR) applied in an art rejection. This is a competitor's magazine which also prints discussions from a competing online Dental forum in the circulated print magazine. Applicant chose to cite the March 2003 issue of DPR in an IDS. That issue makes it clear that not only is applicant a subscriber, but that the relevant feature is a recurring monthly feature. Examiner therefore found and applied the previous issue in the art rejection. This Jan/Feb 03 issue also makes it clear that it is a recurring feature, thereby indicating that earlier issues would have the same feature. Applicant now attempts to swear behind this Jan/Feb 03 reference. Examiner would like to determine the earliest issue of DPR that includes the relevant feature. Examiner would also like to determine the earliest pubic disclosure of applicant's claimed features. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:
  - a. As both a subscriber to and a competitor to Dental Practice Report magazine, what is the earliest issue of DPR known to include a feature of printing content from an online Dental forum? The Jan/Feb 2003 issue called this the

"Clinically Speaking" feature, whereby content was reproduced from the "Internet Dental Forum."

3. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

a. Applicant states that the invention was completed before Jan 2003 and was implemented in connection with the April 2002 issue of DentalTown magazine, published in April 2002.

i. For the April 2002 DentalTown issue content, was there any indication posted to the online forum or given to the forum users that certain content may be used in a future publication of the magazine? Did users have to acknowledge or indicate that their content may be reprinted in the magazine? Any waivers or agreements? Was there any indication during the user-registration process when users registered with the forum regarding re-publication of their posted content? If there were indications, waivers, agreements, etc., when did these occur? Note that this is relevant because the April 2002 issue of DentalTown magazine cited by applicant shows that the original forum-posted content was made (publicly) at least as early as 2/28/2002 (more than 1 year prior to applicant's provisional date).

- ii. What was the first issue of DentalTown magazine to implement any or all of the claimed features? Especially relevant is the inclusion in the magazine of any content that was previously posted to an online forum.
4. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

***Rule 131 Affidavit***

5. The 131 affidavit filed on 5/26/2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Jan/Feb 2003 Dental Practice Report magazine reference.

- The 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. MPEP 705.07(c).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 32, 49, 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- Claim 32 is an apparatus claim but it concludes with “advertising” and it is not clear whether this is simply a collection of advertising information per se, or whether applicant intends to cover a step of advertising or a mechanism capable of advertising.
- Claims 49, 50, “a format that assists readers in recognizing that the content is selected from the online subject matter” is a relative phrase that attempts to limit the claim to specific format(s). However the particular format or characteristics of the format is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What format “assists”? And how would one of ordinary skill know when a certain a format does not “assist”?

***Claim Rejections - 35 USC § 102, 103***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-13, 16-39, 42-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchida (JP 2001357142 A).** Tsuchida teaches a system and method for soliciting via a computer network opinions, assertions, etc., for a given theme/topic "for discussion and debate" [abstract]. The posted content is then published in a hard-copy publication [abstract]. While there is no patentable distinction made between a book or a magazine, it would have been obvious to one of ordinary skill at the time of the invention to have published the content of Tsuchida's submitted postings in the form of a magazine as this is a common publication format that is easy to carry and read. Because the posts are taken to be relevant to the theme and because Tsuchida describes the posts as offering discussion and debate, the collection of submitted content is taken to be representative of a "thread" from an online forum – regardless of whether the posts can be read electronically. Although Tsuchida states that a book is published for those who "enjoy reading books", it would have been obvious to one of ordinary skill at the time of the invention to have also posted the theme submissions to an electronic forum (in addition to the "books") so that people who enjoy reading online electronic forums can also enjoy the "debate" and "discussions" by reading them online. Posters to the forum are put on notice (permission) that the content they provide to the online forum may be used in the publication. Any readable format printed in the magazine is taken to be recognizably similar (i.e. readable) to that in the forum. It is well known that publications are subsidized by advertising and it would have been obvious to one of ordinary skill at the

time of the invention to have provided advertising that is related to the theme/content of the publication. The particular theme/industry is not a patentable distinction and it would have been obvious to one of ordinary skill at the time of the invention to have provided content for publications of any theme, including dentistry and to therefore have offered such a publication to dentists or others interested in the dentistry field. Tsuchida does not appear to mention any costs for posting to the forum and it would have been obvious to one of ordinary skill at the time of the invention to have provided the forum for free in order to attract the most content. Official Notice is also taken that magazines, especially trade journals are provided to customers for free, subsidized by advertising. It is also well known for online forums to require registration and it would have been obvious to one of ordinary skill at the time of the invention to have restricted registration to those users having qualifying knowledge in the subject area so as to avoid spam and other unwanted postings. It would have been obvious to one of ordinary skill at the time of the invention to have selected the most popular forum threads for inclusion in the publication in order to provide a popular publication. Applicant's claimed features regarding forum properties (screen names, avatars, post numbers, etc) that are included in the magazine are taken to be standard information elements captured and presented by most online forum systems - including "Ultimate Bulletin Board" apparently put to use by the applicant and would be obvious to include when printing forum posting content in the magazine for full disclosure and interest. The particular format and shading techniques used in the publication are taken to be mere decorative design choices and are not given substantial patentable weight.



11. **Claims 14, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchida (JP 2001357142 A) in view of Kasai (US20020169688).**

12. Regarding claims 14, 40, while it would have been obvious to one of ordinary skill at the time of the invention to have provided advertising inside the publication of Tsuchida, and to have located the advertising arbitrarily, including on every page, there is no explicit teaching of printing advertising related to the subject matter of a proximal article/content. Kasai however teaches that such a practice is commonplace in the publishing industry and that measures are taken to place on-page ads relevant to the subject matter of adjacent article content, so as to increase the effectiveness of the advertising [¶ 0014]. It would have been obvious to one of ordinary skill at the time of the invention to have located advertising which is related to the publication's content of the user's forum posts, So as to provide effective advertising.

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13. **Claims 1, 2, 5, 16, 19, 26, 29-32 are alternatively rejected under 35 U.S.C. 102(a) as being anticipated by Dental Practice Report (Jan/Feb 2003 issue).**

14. Regarding claims 1, 2, 30-32, Dental Practice Report is taken to be a magazine provided to subscribing Dentists and others having interest in the common subject area of dentistry (i.e. to a substantial portion of a vertical market – the dental market). Dental Practice Report makes it clear that clinical discussions (i.e. threads) among the members of the Internet Dental Forum (online forum - IDF) are compiled and published in the magazine. The "manufacturer sponsored reports" indicated as being located on

page 41 which are devoted to Ivoclar Vivadent's "VPS Virtual Impression System" and Dentsply Gendex's "DenOptix Digital Imaging System" are taken to represent printed advertising for those products. Further, classified advertising is indicated as being on page 63, and an advertisers index on page 65.

15. Regarding claim 5, the contributors to the threads are taken to inherently represent a subset of the forum.

16. Regarding claim 16, the printed content is in a format using an initial question, followed by interactive responses to the question and previous responses, each followed by the author of the post. This is therefore taken to be a format which assists readers in recognizing that the threads are from the online forum.

17. Regarding claims 19, Dental Practice Report prints the city and state for each poster.

18. Regarding claim 26, the posts are taken to be printed chronologically because there is a question that Ken responds to and the subsequent posters also refer to Ken's response.

19. Regarding claim 29, there are at least 3 posts printed.

**20. Claims 3, 4, 6-13, 17, 18, 20-25, 27, 28, 33-39, 42-50 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Dental Practice Report (Jan/Feb 2003 issue).**

21. Regarding claims 3, 4, 35, 36, it is not clear whether a fee is charged to receive the magazine or to access the Internet Dental Forum (IDF). However, Official Notice is

taken that it is well known to offer trade magazines for free (subsidized by advertising) as well as to offer online discussion forums for free (such as USENET's sci.med.dentistry which dates to approx. 1993). It would have been obvious to one of ordinary skill at the time of the invention to have offered both the magazine and the forum for free so as to attract a wide readership.

22. Regarding claims 6-8, 37, it would have been obvious to one of ordinary skill at the time of the invention to have disclosed to the forum contributors how their content may be used so as to provide a truthful understanding of the forum's practices. Official Notice is taken that giving permission to publish, waiving rights to content are generally accepted practices.

23. Regarding claims 9, 10, Official Notice is taken that certain online forums are "moderated" so as to keep the discussions ontopic, to avoid spam, to avoid abusive arguments, etc. It would have been obvious to one of ordinary skill at the time of the invention to have provided a moderation feature to eliminate posts from spammers, for example. Asking a new registrant to answer a question pertaining to the level of expertise desired for joining the discussions would have been an obvious way to eliminate spammers.

24. Regarding claims 11-13, 33, 34, 38, 39, it would have been obvious to one of ordinary skill at the time of the invention that popular threads (according to any well known metric) would tend to have provided popular printed content in the magazine. It would have been obvious to one of ordinary skill at the time of the invention to have

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selected the most popular forum threads for inclusion in the publication in order to provide a popular publication.

25. Regarding claims 17, 18, 20-25, 27, 28, 42-47, Official Notice is taken that applicant's claimed features regarding forum properties (screen names, avatars, post numbers, post time/date, registration date, number of posts, alternate shaded posts, etc) that are included in the magazine are taken to be standard information elements captured and presented by most online forum systems - including the prior art "Ultimate Bulletin Board (UBB)" software apparently chosen to run applicant's DentalTown forum and would be obvious to include when printing forum posting content in the magazine for full disclosure and interest. The particular format and shading techniques used in the publication are taken to be mere decorative design choices and are not given substantial patentable weight.

26. Regarding claim 48, there are at least 3 posts printed.

27. Regarding claims 49, 50, it would have been obvious to one of ordinary skill at the time of the invention to have edited any spelling errors in the original posts so that the magazine can be free of spelling errors.

28. **Claims 14, 40 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Dental Practice Report in view of Kasai (US20020169688).**

29. Regarding claims 14, 40, while it would have been obvious to one of ordinary skill at the time of the invention to have provided as much advertising as desired including on every page, there is no explicit teaching of printing advertising related to the subject

matter of a proximal article/content. Kasai however teaches that such a practice is commonplace in the publishing industry and that measures are taken to place on-page ads relevant to the subject matter of adjacent article content, so as to increase the effectiveness of the advertising [¶ 0014]. It would have been obvious to one of ordinary skill at the time of the invention to have located for example advertising related to a provider of articaine proximal to the content from of the forum's discussions of articaine.

### ***Response to Arguments***

30. Applicant argues that Tsuchida does not provide an online forum or threads. Examiner disagrees. Because the posts are taken to be relevant to the theme and because Tsuchida describes the posts as offering discussion and debate, the collection of submitted content is taken to be representative of a "thread" from an online forum – regardless of whether the posts can be read electronically. Nonetheless, it would have been obvious to one of ordinary skill at the time of the invention to have also posted the theme submissions to an electronic forum (in addition to the "books") so that people who enjoy reading online electronic forums can also enjoy the "debate" and "discussions" by reading them online.

31. Applicant argues that that Tsuchida teaches away from advertising revenue because he sells his books. It is not clear where the teaching AWAY is present in Tsuchida. Silence on advertising is not equivalent to teaching away. Further magazines are notorious for not only being sold, but also including advertising; the same could apply to books.

32. Applicant argues that there are other ways to eliminate spam posts, yet it is believed to have used moderation techniques such as answering a question in order to limit participation .

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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